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EXAMINER	
BOVEJA, NAMRATA	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/973,671	MAGOSHI, HIDETAKA	
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 03/28/2007.

2. Claims 1-34 are presented for examination.

3. Amendments to the claims have been entered and considered.

Objections

4. Applicant's claim amendments require the Applicant to renumber the claims accordingly. For example, claim 2 depends from claim 21, and it is listed before claim 21. Appropriate correction is required.

5. Applicant's claim amendments state "421" in claims 2 and 3. This should be corrected to clearly recite 21. Appropriate correction is required.

6. Applicant's claims 29 and 30 recite, "service include" and should instead recite, "service includes." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 7, 10, 13, and 16-19 are rejected under 102(b) as being anticipated by Marino et al. Patent Number 4,850,007 (hereinafter Marino).

In reference to claims 1, 4, 7, and 16, Marino teaches a method, program, a computer-readable recording medium, and a program-executing apparatus of providing services that makes a computer execute the steps of: making service beneficiaries

select *a* frequency of advertising to be added the services provided *(i.e. frequency is equivalent to selecting the amount of time for which the advertisements will be displayed)* (col. 4 lines 44-60), the services being provided when the selection is made (col. 4 lines 1-15 and 44-60); and setting a fee for the provision of services to the service beneficiaries, according to the frequency of advertising selected *(i.e. frequency is equivalent to selecting the amount of time for which the advertisements will be displayed)* (col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20).

8. In reference to claim 10, Marino teaches a contents distribution system, comprising: client terminal unit connected to a predetermined network (i.e. a phone connected to a network), and having selecting means (i.e. having buttons) for selecting *a* frequency *of* advertising be added to the contents be distributed (col. 4 lines 53-60 and Figure 1); and distribution unit having distribution means distributing the contents added with the advertising corresponding to least of frequency and the quantity selected by the selecting means of the client terminal the client terminal via the predetermined network (i.e. a monitor, television screen, and/or telephone) (col. 4 lines 1-4 and 53-60 and Figure 1), and charging means for charging a fee for the contents distributed to the client terminal unit (i.e. billing portion) (col. 4 lines 16-20 and Figure 2), according to at *a* frequency of advertising selected by the selecting means the client terminal unit (col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20); wherein the selecting means communicates with the distribution means to perform the selection (i.e. based on the user selection, advertisements are selected from the databank and provided to the user) (col. 1 lines 49-54 and col. 4 lines 53-60).

9. In reference to claims 13 and 17, Marino teaches a computer-readable recording medium recorded with a contents distribution program and a contents distribution program, the contents distribution program comprising and making a computer execute the steps of: making a client terminal unit connected to predetermined network select *a* frequency of advertising to be added to the contents to be distributed (i.e. user can select how many minutes of advertising the user wants to see and/or hear) (col. 4 lines 53-60); making a distribution unit connected to the predetermined network add the advertising corresponding to the frequency selected by the client terminal unit to the contents, and distribute the contents added with the advertising to the client terminal unit (col. 1 lines 49-54 and col. 4 lines 1-15 and lines 57-60); and making the distribution unit charge a fee for the contents distributed to the client terminal unit (i.e. billing portion) (col. 4 lines 16-20 and Figure 2), according to the frequency and the quantity of advertising selected by the client terminal unit (col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20); wherein the contents are distributed when the selection is made (col. 4 lines 53-60).

10. In reference to claim 18, Marino teaches the method of providing services wherein the selection is received via a user interface (i.e. the user selects the number of minutes of advertisements via the phone) (col. 4 lines 53-60); and the services are provided via the user interface (i.e. the advertisements are sent via the phone) (col. 4 lines 53-60).

11. In reference to claim 19, Marino teaches the method of providing services wherein: the provision of the services is interrupted when the advertisement information

is being received by the user (col. 3 lines 16-41 and col. 4 lines 1-11), and the provision of services is restarted after the receiving of the advertisement information is completed (col. 4 lines 1-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 15, and 20-27 are rejected under U.S.C. 103(a) as being unpatentable over Marino.

In reference to claims 21-23 and 26, Marino teaches the method of providing services wherein the service beneficiaries select the frequency of advertising to be added to the services provided (col. 4 lines 53-60), and setting a fee for the provision of services to the service beneficiaries, according to the frequency of advertising selected (i.e. frequency is equivalent to selecting the amount of time for which the advertisements will be displayed) (col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20). Although Marino does not expressly state the method of providing services wherein the service beneficiaries select the quantity of advertising, and setting a fee for the provision of services to the service beneficiaries, according to the quantity of advertising selected, determining the quantity of advertising and setting the fee according to the quantity of advertising selected is an obvious variant of determining the

frequency of advertising and setting the fee according to the frequency of the advertising select, and once one of these two variables is known in addition to the variable of time as disclosed in Marino, a simple mathematical manipulation would yield the other variable. For example, if a user selects 1 minute of advertising, and the length of each commercial is 15 seconds, we know that the quantity of advertising will be 4 advertisements per minute and to charge a fee according the number of advertisements instead of the frequency of advertising selected. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Marino's method of advertising to also include the option of enabling the service beneficiaries to select the quantity of advertising to be added to the services provided and to charge according to the quantity of advertising selected, because it is well known in the art to let users select how many advertisements they would like to listen to or let the users pick a duration of time for listening to advertisements and letting a computer system figure out how many advertisements can fit in that time period and how much to charge the users either according to the number of advertisements selected or the frequency of advertisements selected.

13. In reference to claim 20, Marino teaches the method of providing services wherein the service beneficiaries select the frequency of advertising to be added to the services provided (col. 4 lines 53-60). Although Marino does not expressly state the method of providing services wherein the service beneficiaries select the quantity of advertising, determining the quantity of advertising is an obvious variant of frequency of advertising, and once one of these two variables is known in addition to the variable of

time as disclosed in Marino, a simple mathematical manipulation would yield the other variable. For example, if a user selects 1 minute of advertising, and the length of each commercial is 15 seconds, we know that the quantity of advertising will be 4 advertisements per minute. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Marino's method of advertising to also include the option of enabling the service beneficiaries to select the quantity of advertising to be added to the services provided, because it is well known in the art to let users select how many advertisements they would like to listen to or let the users pick a duration of time for listening to advertisements and letting a computer system figure out how many advertisements can fit in that time period.

14. In reference to claims 24, 25, and 27, Marino teaches the method of providing services wherein the service beneficiaries select the frequency of advertising to be added to the services provided (col. 4 lines 53-60), and a distribution unit charging means for charging a fee for the provision of services to the service beneficiaries, according to the frequency of advertising selected (i.e. frequency is equivalent to selecting the amount of time for which the advertisements will be displayed) (col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20). Although Marino does not expressly state the method of providing services wherein the service beneficiaries select the quantity of advertising, and charging a fee for the provision of services to the service beneficiaries, according to the quantity of advertising selected, determining the quantity of advertising and charging the fee according to the quantity of advertising selected is an obvious variant of determining the frequency of advertising and setting the fee

according to the frequency of the advertising select, and once one of these two variables is known in addition to the variable of time as disclosed in Marino, a simple mathematical manipulation would yield the other variable. For example, if a user selects 1 minute of advertising, and the length of each commercial is 15 seconds, we know that the quantity of advertising will be 4 advertisements per minute and to charge a fee according the number of advertisements instead of the frequency of advertising selected. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Marino's method of advertising to also include the option of enabling the service beneficiaries to select the quantity of advertising to be added to the services provided and to charge according to the quantity of advertising selected, because it is well known in the art to let users select how many advertisements they would like to listen to or let the users pick a duration of time for listening to advertisements and letting a computer system figure out how many advertisements can fit in that time period and how much to charge the users either according to the number of advertisements selected or the frequency of advertisements selected.

Marino also teaches the distribution means to distribute the contents added with the advertising further corresponding to the frequency selected by the selecting means of the client terminal unit (col. 3 lines 61-68, col. 4 lines 53-60, and col. 5 lines 32-37). Although Marino does not expressly teach the means to distribute the contents added with the advertising further corresponding to the quantity selected by the selecting means of the client terminal unit, determining the quantity of advertising and distributing

content based on the selected quantity of advertising is an obvious variant of determining the frequency of advertising and distributing content based on the selected frequency of the advertising selected, and once one of these two variables is known in addition to the variable of time as disclosed in Marino, a simple mathematical manipulation would yield the other variable. For example, if a user selects 1 minute of advertising, and the length of each commercial is 15 seconds, we know that the quantity of advertising will be 4 advertisements per minute and to charge a fee according the number of advertisements instead of the frequency of advertising selected. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Marino's method of advertising to also include the option of enabling the service beneficiaries to select the quantity of advertising to be added to the services provided and to distribute the contents according to the quantity of advertising selected, because it is well known in the art to let users select how many advertisements they would like to listen to or let the users pick a duration of time for listening to advertisements and letting a computer system figure out how many advertisements can fit in that time period.

15. In reference to claims 2, 5, 8, 11, and 14, Marino teaches the method, computer-readable medium of providing services, the program-executing apparatus (i.e. a monitor or television set), the contents distribution system (i.e. a databank), and the computer-readable recording medium recorded with a contents distribution program (i.e. software) that makes a computer execute the steps of setting fees wherein the fees charged for the services to be provided to the service beneficiaries are set at discrete *amounts* (i.e.

a rate reduction per call) of the frequency and the quantity of advertising selected by the selecting means of the client terminal unit (col. 1 lines 54-58, col. 2 lines 36-41, and col. 4 lines 16-20); and at least one of the discrete *amounts* includes free of charge (i.e. coupons good for the purchase of merchandise or services could be the form, in whole, or in part, that the caller may receive as value for his cooperation) (col. 2 lines 36-41).

16. In reference to claims 3, 6, and 9, Marino teaches a method, computer-readable medium, and the program-executing apparatus of providing services and the program-executing apparatus, wherein, at least one of the frequency and the quantity advertising selected can be changed during the provision the services (i.e. can select how many minutes of advertising you want to hear *after making the call to the toll free number for service delivery or select options for additional advertising information during the phone call*) (*col. 2 lines 26-29,* col. 4 lines 44-60, *and col. 5 lines 32-37*).

17. In reference to claims 12 and 15, Marino teaches the contents distribution system wherein the client terminal unit has changing means for assigning a change and the computer-readable recording medium comprising and making a computer assign a change in at least one of the frequency *or* the quantity of advertising during the reception of the contents (i.e. user can select how many minutes of advertising the user wants to see and/or hear) (col. 4 lines 53-60), the changing means including an interface (i.e. a phone pad is an interface) adapted to accept a modification of the selection of at least one of the frequency and the quantity of advertising to be added to the contents to be distributed (i.e. user can select to hear other advertisements detailing a given advertisement) (col. 2 lines 26-29), and the distribution means of the distribution

unit adds the advertising according to at least one of the frequency and the quantity changed by the changing means of the client terminal unit, and distributes the contents added with the advertising to the client terminal unit (i.e. based on the user selection, advertisements are selected from the databank and provided to the user) (col. 1 lines 49-54 and col. 4 lines 53-60).

18. Claims 28, 30, 31, 32, and 34 are rejected under U.S.C. 103(a) as being unpatentable over Marino in view of Toader Patent Number 5,774,869 (hereinafter Toader).

In reference to claim 28, Marino does not teach the method of providing services wherein the services include internet access. Toader teaches the method of providing services wherein the services include interact access (abstract, col. 2 lines 29 to col. 3 lines 3, col. 4 lines 1-5, col. 5 lines 10-15, and Figure 1). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the method of providing services wherein the services include internet access in Marino's invention to enable the user to gain free internet access for viewing advertisements instead of just gaining free phone access by listening to advertisements, since some users may be in need of subsidized internet service but not phone service and vice versa.

19. In reference to claim 30, Marino does not teach the program-executing apparatus for executing a computer program, wherein the service includes internet access. Toader teaches the program-executing apparatus for executing a computer program, wherein the service includes internet access (col. 4 lines 6-30 and Figure 1). It would

have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the program-executing apparatus for executing a computer program, wherein the service includes internet access in Marino's invention to enable the user to gain free internet access for viewing advertisements on a computer instead of just gaining free phone access by listening to advertisements on a phone, since some users may be in need of subsidized internet service but not phone service and vice versa.

20. In reference to claims 31 and 34, Marino does not teach the contents distribution system and program wherein the predetermined network includes the internet. Toader teaches the contents distribution system and program (i.e. a browser that distributes advertising information over the internet on a computer) wherein the predetermined network includes the internet (col. 2 lines 29 to col. 3 lines 3, col. 4 lines 6-56, and Figure 1). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the contents distribution system and program wherein the predetermined network includes the internet in Marino's invention to enable the user to gain free internet access for viewing advertisements on a computer instead of just gaining free phone access by listening to advertisements on a phone, since some users may be in need of subsidized internet service but not phone service and vice versa.

21. In reference to claim 32, Marino does not teach the computer-readable recording medium recorded with a contents distribution program, wherein the predetermined network includes the internet. Toader teaches the computer-readable recording

medium recorded with a contents distribution program (i.e. a web browser connected to the internet), wherein the predetermined network includes the internet (col. 2 lines 29 to col. 3 lines 3 and col. 4 lines 6-56). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the computer-readable recording medium recorded with a contents distribution program, wherein the predetermined network includes the internet in Marino's invention to enable the user to gain free internet access for viewing advertisements on a computer instead of just gaining free phone access by listening to advertisements on a phone, since some users may be in need of subsidized internet service but not phone service and vice versa.

22. Claims 29 and 33 are rejected under U.S.C. 103(a) as being unpatentable over Marino in view of Toader Patent Number 5,774,869 (hereinafter Toader) and further in view of Official Notice.

In reference to claims 29 and 33, Marino does not teach the computer-readable recording medium recorded with a service-providing program wherein the service includes intemet access. Toader teaches computer-readable recording medium with a service-providing program wherein the service includes intemet access (col. 2 lines 29-56 and Figure 1). Toader does not teach having the internet access program recorded on a computer. Official Notice is taken that it is old and well known to pre-install/record internet access programs such as a free trial of America Online (AOL) on a computer. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to record the internet access program on the computer to prevent the user from having to take the time to install mailed discs and to make sure the

program does indeed get installed on the computer for potential use by the user.

Response to Arguments

23. After careful review of Applicant's remarks/arguments filed on 03/28/2007, the Applicant's arguments with respect to claims 1-20, and the newly added claims 21-34 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

24. The previously made objection for claims 1, 4, 7, and 16 has been removed, however new objections for claims 2, 3, 29, and 30 have been introduced as well an objection regarding the need for renumbering the claims which has also been introduced.

25. In reference to claim 1 or any of the other independent claims, the Applicant argues that Marino does not teach selecting a frequency of advertising. The Examiner respectfully disagrees and would like to point the Applicant to (col. 4 lines 44-60), since frequency is equivalent to selecting the amount of time for which the advertisements will be displayed as taught by Marino.

26. In reference to claims 3, 6, and 9, the Applicant argues that Marino does not teach that the selection may be changed during the provision of services. The Examiner respectfully disagrees and would like to point the Applicant to (col. 2 lines 26-29, col. 4 lines 44-60, and col. 5 lines 32-37), where it is disclosed that the user can select how many minutes of advertising he wants to hear after making the call to the toll free number for service delivery or select options for additional advertising information during the phone call such as more additional advertising information for a particular

sponsor, and therefore Marino teaches the limitation that the selection may be changed during the provision of services.

27. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central Fax Number** for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

June 11th, 2007

RAQUEL ALVAREZ
PRIMARY EXAMINER